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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,150	05/03/2006	Jun Seok Park	3449-0619PUS1	8811
2292 7590 12/11/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER PHAM, THANH V				
ART UNIT 2894		PAPER NUMBER		
NOTIFICATION DATE 12/11/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/578,150

**Applicant(s)**

PARK, JUN SEOK

**Examiner**

THANH V. PHAM

**Art Unit**

2894

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 19-24 and 28-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date 09/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of the first species (claims 1-18 and 25-27) in the reply filed on 10/29/2008 is acknowledged. Applicant argues that "examination of both species together in one application would not place an undue burden on the Examiner". This is not found persuasive because the search could not go to both structures at the same time.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102 and § 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-9, 11-15 and 25-27 are rejected under 35 U.S.C. 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mazzochette et al. US Pub. 2004/0022433.

Re claim 1, the Mazzochette et al. reference discloses a light emitting device package, comprising:

a metal base 11;

an electrical circuit layer 13 provided at an upper side of the metal base for providing a conductive path (see [0025] and argument on element 17 in [0027] and [0030]-[0032]);

an insulating layer 12 sandwiched between the metal base and the electrical circuit layer;

a light emitting device 10 mounted on the top surface of the metal base in an open space from which the insulating layer 17 is removed;

an electrode layer 55 provided at an upper side of the electrical circuit layer (see also element 17 as above); and

a connection portion 54 (in fig. 5, e.g.) for electrically connecting the electrode layer and the light emitting device (see further in [0034]).

Re claim 2, the light emitting device package further comprising a molding portion for molding the inside of the open space (last lines of [0050]).

Re claim 3, the light emitting device package further comprising a heat sink (connected to element 16 which is not shown in the figures) formed on the bottom surface of the metal base.

Re claim 4, the light emitting device package further comprising a heat sink combined to the metal base by a screw 95.

Re claim 5, the light emitting device package further comprising a heat sink that comes in contact with one surface of the metal base with a heat transfer material 16 embedded therein.

Re claim 6, in the light emitting device package, the open space is processed by milling, [0049].

Re claim 8, in the light emitting device package, the light emitting device is one or more LED chips selected from the group consisting of a red LED chip, a green LED chip, a blue LED chip, a yellow LED chip and an orange LED chip, [0043], e.g.

Re claim 9, in the light emitting device package, the light emitting device comes in contact with the metal base, fig. 3, e.g.

Re claim 10, in the light emitting device package, the light emitting device consists of one or more SiOB chips, figs. 14-16.

Re claim 11, in the light emitting device package, the light emitting device is combined to the metal base by a thermal conductive hardening agent 59.

Re claim 12, in the light emitting device package, the light emitting device is provided in a plurality of modules on one metal base, and the electrical circuit layer serially connects the respective modules, [0040]-[0043], e.g.

Re claim 13, in the light emitting device package, the light emitting device is provided in a plurality of modules on one metal base, and the modules are arranged in either straight line, round or polygon, figs. 8-12.

Re claims 14-15, in the light emitting device package, a plating layer is provided on the top surface of the electrode layer, wherein the electrode layer is plated with gold, [0029], e.g.

5. Claims 7, 16-18 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzochette et al. as applied to claims 1-6, 8-10, 11-15 and 25-27 above, and further in view of the following.

Re claims 16-17, in the light emitting device package, one of ordinary skill in the art would have been led to the recited dimensions through routine experimentation and optimization. Applicant has not disclosed that the dimensions are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical, and it appears prima facie that the process would possess utility using another dimension. Indeed, it has been held that mere dimensional limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See, for example, *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See also MPEP 2144.04(IV)(B).

Re claims 7, 18, and 25-27, the "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); and *In re Marosi et al.*, 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and

that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Therefore, in the light emitting device package, the open space could be processed by etching, the electrode layer could be formed by an electroplating method, a silk screen layer could be formed on the top surface of the electrode layer then a lens portion attached to the silk screen layer and/or the light emitting device could be molded by resin forming the lens portion or the lens portion could be molded.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THANH V. PHAM whose telephone number is (571) 272-1866. The examiner can normally be reached on M-T (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly D. Nguyen can be reached on 571-272-2402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/05/2008  
/THANH V. PHAM/  
Primary Examiner, Art Unit 2894